

## REMARKS

### Rejection of claims 1, 6-7, 9, 12, 16-17 and 19 under 35 U.S.C. §103(a) as being unpatentable over Tuoriniemi in view of Dias

The Examiner rejected claims 1, 6-7, 9, 12, 16-17 and 19 under 35 U.S.C. §103(a) as being unpatentable over the combination of Tuoriniemi and Dias. In the rejection of claims 1 and 12, the Examiner admits that Tuoriniemi and applicant's discussion of the prior art is silent on a display that displays information regarding at least one channel that is not selected wherein the displayed information is derived from the identifying information for the at least one channel that is not the selected channel. The Examiner then cites to the television channel map in Dias, and states that one skilled in the art would adapt this capability of viewing/listening to one channel while being able to see other non-selected channels for radio.

In discussing the limitations in claims 1 and 12, the Examiner has failed to address a very important limitation. Each of the pending claims includes a display *within the satellite radio receiver* that displays information regarding a non-selected channel. Dias displays its channel map on a television. A television is a visual and audio medium. As such, it requires a screen to display the television images. Because a television inherently has a large display area on its screen, an online channel guide may be displayed on the same screen as discussed in Dias. A satellite radio receiver, in contrast, is a device for providing audio programming to a user. A display on known satellite radio receivers only provides information about the currently-selected channel. Displays on known satellite receivers have very limited display areas, as shown by FIG. 7 of Shigematsu. For this reason, it would not have been obvious to one of ordinary skill in the art to apply the principles of a TV channel guide in Dias to a satellite radio receiver, because satellite radio receivers typically have such a limited display area that display of the channel guide in Dias would be impossible. Nowhere does either Tuoriniemi nor Dias teach or suggest

that an online channel guide could be displayed *on the display of a satellite radio receiver*.

The “display” in Dias is a television. For the Examiner’s rejection to make sense, he would have to assert that one of ordinary skill in the art would be motivated to provide a television screen or other relatively large display within a satellite radio receiver. Nowhere does Dias nor Tuoriniemi teach or suggest that a channel guide may be displayed on the display of a satellite radio receiver. For this reason, claims 1, 6-7, 9, 12, 16-17 and 19 are allowable over the combination of Tuoriniemi and Dias.

It is useful to consider the state of the art in satellite television receivers, which typically provide a channel guide as taught in Dias. Applicants’ attorney owns an EchoStar satellite television receiver for receiving satellite programming from DishNetwork. This satellite television receiver has a single green light emitting diode (LED) that indicates when the receiver is on. There is no display of any other information in the receiver. The only “display” is via a television coupled to the satellite television receiver. The combination of a satellite television receiver and an external television does not read on a display “within the satellite radio receiver”, as expressly recited in the claims. Applicants respectfully assert that Dias expressly teaches away from a display on the satellite television receiver because it would never be needed when a television is coupled to a satellite television receiver. The TV would always serve as the display. Because satellite TV is both visual and audio, the visual display (TV) will always be present, making any sort of display that provides channel information on the satellite TV receiver itself redundant and unnecessarily costly.

The Examiner’s liberal application of the teachings of channel guides for TVs to a satellite radio receiver ignores the fundamental differences between the two. Televisions are visual devices that require a large, detailed display screen to display TV programs. Because the screen is already present to display TV programs, the screen may also be

used to display programming information, such as the channel guide in Dias. A satellite radio receiver, in contrast, is an audio device that outputs a selected audio program. A limited display is generally provided to display information regarding the currently selected audio program. Because satellite radio is an audio medium, one skilled in the art would not be motivated to incorporate a relatively large display into a satellite radio receiver to display a channel guide as taught in Dias. Note that the channel guide in Dias displays many channels, while the display shown in FIG. 4 of applicants' disclosure shows the display of only three non-selected channels. This limited display of a few non-selected channels would not be obvious in light of the teachings of channel guides for TVs as taught by Dias.

Applicants respectfully assert that the Examiner's rationale for combining Tuoriniemi and Dias is improper. The Examiner states:

It would have been obvious to one skilled in the art at the time of the invention to modify Tuoriniemi, such that the system displays at least one channel that is not selected, to provide means for a user to simultaneously listen to one station/song while viewing if there is another station/song they prefer to switch to.

If we strip away the specific language the Examiner uses, the Examiner's rationale basically states that it would be obvious to modify Tuoriniemi with the channel guide taught in Dias to provide the advantages of the claimed invention. This is not a proper rationale for combining Tuoriniemi and Dias. If an Examiner could establish obviousness by stating that a combination of reference A and reference B would be obvious because of advantages only taught in the claims, the Examiner's job would be very simple, indeed. Nowhere does Tuoriniemi nor Dias teach or suggest a display within a satellite radio receiver that displays information regarding at least one channel that is not the selected channel. There is no motivation in either of these references to support their combination. The only motivation rests in applicants' claims, which amounts to impermissible hindsight reconstruction. One skilled in the art looking at these two

references would realize that a satellite radio typically does not include a “screen” that is capable of displaying the online channel guide in Dias, and would therefore not be motivated to apply the teachings of Dias to Tuoriniemi as suggested by the Examiner. For these many reasons given above, applicants respectfully assert that the Examiner’s rejection of claims 1, 6-7, 9, 12, 16-17 and 19 is improper, and respectfully request reconsideration of the Examiner’s rejection of these claims under 35 U.S.C. §103(a).

Rejection of claim 2 under 35 U.S.C. §103(a) as being unpatentable over Tuoriniemi and Dias in view of Shigematsu

The Examiner rejected claim 2 under 35 U.S.C. §103(a) as being unpatentable over the combination of Tuoriniemi, Dias and Shigematsu. In rejecting claim 2, the Examiner states: “Tuoriniemi teaches claim 1 but is silent on further comprising memory coupled to the satellite radio processor, the memory containing at least one channel preset.” This statement by the Examiner is incorrect. Tuoriniemi does not teach claim 1. The rejection of claim 1 relies upon the combination of Tuoriniemi and Dias. Because Tuoriniemi alone does not teach claim 1, as asserted by the Examiner, the Examiner has failed to establish a prima facie case of obviousness for claim 2. In addition, claim 2 depends on claim 1, which is allowable for the reasons given above. As a result, claim 2 is also allowable as depending on an allowable independent claim.

Rejection of claims 3-4, 10-11, 13-14 and 20-21 under 35 U.S.C. §103(a) as being unpatentable over the combination of Tuoriniemi, Dias, Shigematsu and Yuen

The Examiner rejected claims 3-4, 10-11, 13-14 and 20-21 under 35 U.S.C. §103(a) as being unpatentable over the combination of Tuoriniemi, Dias, Shigematsu and Yuen.

### Claims 3 and 13

In rejecting claims 3 and 13, the Examiner states: "Tuoriniemi teases [sic] claim 2 but is silent on wherein the memory further contains a list of favorite channels, wherein the at least one channel that is not selected is in the list of favorite channels." This statement by the Examiner is incorrect. Tuoriniemi does not teach claim 2. The rejection of claim 2 relies upon the combination of Tuoriniemi, Dias and Shigematsu. Because Tuoriniemi alone does not teach claim 2, as asserted by the Examiner, the Examiner has failed to establish a prima facie case of obviousness for claims 3 and 13.

In the rejection, the Examiner states that Yuen teaches a television tuning system and controller that provides memory to store favorite channels, citing the abstract of Yuen. The abstract of Yuen cited by the Examiner contains no reference to memory for storing favorite channels. Yuen does teach in FIGS. 15 and 39 the display of channels according to the program that is currently playing on a channel. Thus, referring to FIG. 15 of Yuen, if NBC is currently playing a comedy movie, the channel NBC will be listed if the category of "COMEDY MOVIES" is selected. Yuen thus discloses filtering the channel list according to current programming. This, however, is not the same thing as a list of favorites. The channel guide for NBC will change from one category to another depending on the current program that is playing. For this reason, the filtered lists in Yuen do not read on the list of favorite channels recited in claims 3 and 13, so claims 3 and 13 are allowable over the combination of Tuoriniemi, Dias Shigematsu, and Yuen. In addition, claim 3 depends on claim 2, which depends on claim 1, which is allowable for the reasons given above, and claim 13 depends on claim 12, which is allowable for the reasons given above. As a result, claims 3 and 13 are also allowable as depending on allowable independent claims. For the many reasons given above, applicants respectfully request reconsideration of the Examiner's rejection of claims 3 and 13 under 35 U.S.C. §103(a).

#### Claims 4 and 14

In rejecting claims 4 and 14, the Examiner states: "Tuoriniemi teaches [sic] claim 3 but is silent on wherein the list of favorite channels is at least partially defined by the at least one channel preset." This statement by the Examiner is incorrect. Tuoriniemi does not teach claim 3. The rejection of claim 3 relies upon the combination of Tuoriniemi, Dias, Shigematsu, and Yuen. Because Tuoriniemi alone does not teach claim 3, as asserted by the Examiner, the Examiner has failed to establish a prima facie case of obviousness for claims 4 and 14.

In the rejection, the Examiner states that Yuen teaches that memory contains a favorite channel list that includes a list of channel identifiers, each channel identifier corresponding to one of a subset of the set of channels received by the tuner, citing the abstract of Yuen. The abstract of Yuen cited by the Examiner contains no reference to memory for storing favorite channels, and has no reference to channel identifiers. Yuen does teach in FIGS. 15 and 39 the display of channels according to the program that is currently playing on a channel, as discussed above with respect to claims 3 and 13. The filtered channel list of Yuen does not read on a list of favorite channels, as recited in claims 4 and 14. The channel guide for NBC will change from one category to another depending on the current program that is playing. For this reason, the filtered lists in Yuen do not read on the list of favorite channels recited in claims 4 and 14. Furthermore, the presets in claim 2 were supposedly disclosed in the radio of Shigematsu, while the favorite channels were supposedly disclosed in the TV listing in Yuen. How could the TV listings in Yuen be defined by a radio preset in Shigematsu? It clearly can't. Applicants respectfully submit that a list of favorite channels that is at least partially defined by at least one channel preset, as recited in claims 4 and 14, patentably distinguishes over the combination of Tuoriniemi, Dias, Shigematsu, and Yuen. In addition, claim 4 depends on claim 3, which depends on claim 2, which depends on claim 1, which is allowable for the reasons given above, and claim 14 depends on claim 13,

which depends on claim 12, which is allowable for the reasons given above. As a result, claims 4 and 14 are allowable as depending on allowable independent claims. For the many reasons given above, applicants respectfully request reconsideration of the Examiner's rejection of claims 4 and 14 under 35 U.S.C. §103(a).

#### Claims 10 and 20

Claims 10 and 20 are very detailed claims. The Examiner's attempt to combine four cited references to allegedly render obvious the detailed combination of features in claims 10 and 20 amounts to an attempt to pound a square peg into a round hole: it just doesn't fit. The Examiner has mixed and matched teachings of radio receivers with teachings of TV channel guides. As discussed above in detail with respect to the first claim set, one of ordinary skill in the art would not be motivated to apply the teachings of a TV channel guide to a display in a radio receiver.

In the rejection, the Examiner reads the radiotext of Tuoriniemi as reading on the display of time remaining. First of all, the transmission of radiotext provides information to the receiver that could be displayed, but Tuoriniemi has no explicit teaching of displaying the radiotext. Furthermore, claims 10 and 20 include the limitation of displaying time remaining for the radio program corresponding to the selected channel, and displaying time remaining for the radio program corresponding to the at least one channel that is not the selected channel. None of the four cited references teach or suggest the display of time remaining for a radio program. For this reason, claims 10 and 20 are allowable over the cited combination of Tuoriniemi, Dias, Shigematsu, and Yuen. Applicants respectfully request reconsideration of the Examiner's rejection of claims 10 and 20 under 35 U.S.C. §103(a).

Claims 11 and 21

Claim 11 depends on claim 10, which is allowable for the reasons given above. Claim 21 depends on claim 20, which is allowable for the reasons given above. As a result, claims 11 and 21 are allowable as depending on allowable independent claims, and applicants respectfully request reconsideration of the Examiner's rejection of claims 11 and 21 under 35 U.S.C. §103(a).

Rejection of claims 5 and 15 under 35 U.S.C. §103(a) as being unpatentable over the combination of Tuoriniemi, Dias, Shigematsu, Yuen, and Alexander

The Examiner rejected claims 5 and 15 under 35 U.S.C. §103(a) as being unpatentable over the combination of Tuoriniemi, Dias, Shigematsu, Yuen, and Alexander. In the rejection, the Examiner states: "Tuoriniemi teaches [sic] claim 3 but is silent on wherein the list of favorites is determined by the processor according to which channels are listened to most frequently." This statement by the Examiner is incorrect. Tuoriniemi does not teach claim 3. The rejection of claim 3 relies upon the combination of Tuoriniemi, Dias, Shigematsu, and Yuen. Because Tuoriniemi alone does not teach claim 3, as asserted by the Examiner, the Examiner has failed to establish a prima facie case of obviousness for claims 5 and 15.

In the rejection, the Examiner states:

Alexander teaches a viewer profile which is based upon a person's viewing habits (eg. which shows they watch more frequently than others) and giving them a higher precedence over others in the viewing list AND/OR automatically tuning the TV to that show when it is on (C30, L45-67, see Nick at Night reference).

The Examiner then concludes that it would be obvious based on these teachings in Alexander to determine a list of favorites according to channels more frequently listened



to. This logic forgets one very important point. Alexander does not decide which channels to include or exclude from a list based on which channels are watched more frequently than others. The only thing Alexander does is change the *position* of the channel in the list. Thus, more frequently watched channels could be placed higher on the list, while less frequently watched channels could be placed lower on the list. Nowhere does Alexander teach or suggest including frequently watched channels in a favorite list of channels that does not include all of the channels. For this reason, Alexander does not read on the determining a list of favorites according to which channels are listened to most frequently. For these reasons, applicants respectfully assert that claims 5 and 15 are allowable over the combination of Tuoriniemi, Dias, Shigematsu, Yuen, and Alexander, and applicants respectfully request reconsideration of the Examiner's rejection of claims 5 and 15 under 35 U.S.C. §103(a).

Rejection of claims 8, 18 and 22 under 35 U.S.C. §103(a) as being unpatentable over the combination of Tuoriniemi, Dias and Alexander

The Examiner rejected claims 8, 18 and 22 under 35 U.S.C. §103(a) as being unpatentable over the combination of Tuoriniemi, Dias and Alexander.

Claims 8 and 18

In the rejection of claims 8 and 18, the Examiner states: "Tuoriniemi teaches [sic] claim 1 but is silent on wherein the displayed information includes time remaining for the radio program." This statement by the Examiner is incorrect. Tuoriniemi does not teach claim 1. The rejection of claim 1 relies upon the combination of Tuoriniemi and Dias. Because Tuoriniemi alone does not teach claim 1, as asserted by the Examiner, the Examiner has failed to establish a prima facie case of obviousness for claims 8, 18 and 22 under 35 U.S.C. §103(a).

In the rejection, the Examiner states: "Tuoriniemi teaches radiotext that identifies music, name of performer, change of program, etc., where the examiner interprets "etc." to include time remaining." How very convenient. Absent an express teaching in the cited art, the Examiner takes a simple expression "etc." and reads that expression to include a feature that is only taught in the claims. This amounts to a **CLEAR** case of hindsight reconstruction. How would one skilled in the art be motivated to display time remaining based on the word "etc." in Tuoriniemi? Such a position is borderline ludicrous. Applicants forcefully assert that the word "etc." cannot substitute for a positive recitation or suggestion of the limitation in the claim. Nowhere does ANY of the three references cited against claims 8 and 18 teach, suggest or render obvious the display of time remaining for a song. Again, the Examiner attempts to provide rationale for why it would be obvious, but the only rationale is so one can enjoy the benefits of the claimed invention. As discussed above with respect to claim 1, this does not amount to a proper rationale for combining prior art references. There is no teaching or suggestion in any of the three cited references to support the display of time remaining. The only teaching of displaying time remaining is in the claims themselves. Hindsight reconstruction, pure and simple. Applicants forcefully assert that the combination of Tuoriniemi, Dias and Alexander do not render obvious claims 8 and 18, and that these claims are therefore allowable over the cited art. In addition, claim 8 depends on claim 1, which is allowable for the reasons given above, and claim 18 depends on claim 12, which is likewise allowable. As a result, claims 8 and 18 are also allowable as depending on allowable independent claims. Applicants respectfully request reconsideration of the Examiner's rejection of claims 8 and 18 under 35 U.S.C. §103(a).

#### Claim 22

The Examiner rejects claim 22 using language and rationale similar to the rejection of claims 5 and 15, addressed above. For the reasons given above with respect to claims 5 and 15, claim 22 is likewise allowable. In addition, claim 22 depends on

claim 20, which is allowable for the reasons given above. As a result, claim 22 is also allowable as depending on an allowable independent claim. Applicants respectfully request reconsideration of the Examiner's rejection of claim 22 under 35 U.S.C. §103(a).

#### General Comments

All of the Examiner's rejections reek of hindsight reconstruction. The Federal Circuit has held:

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988)(quoting W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983)).

The Federal Circuit also held:

Care must be taken to avoid hindsight reconstruction by using "the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit." Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988)(quoting Orthopedic Equip. Co. v. United States, 702 F.2d 1005, 1012, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983)).

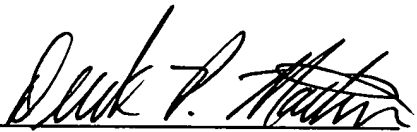
A detailed look at the rejections shows many features and combinations of features that are only disclosed in the claims, yet the Examiner has used the patent claims as a guide through the maze of prior art references, combining the right references in the right way so as to allegedly achieve the result of the claims. This amounts to impermissible hindsight reconstruction. Applicants hereby challenge the Examiner to provide rationale for combining the references that is based on teachings of the references or knowledge in the art, not based on the desirability of the claimed invention. Nowhere do ANY of the

references nor ANY knowledge in the art teach or suggest the desirability of combining features of a TV channel guide with a radio display. For this reason, the pending claims are clearly allowable over the cited art.

Conclusion

In summary, none of the cited prior art, either alone or in combination, teach, support, or suggest the unique combination of features in applicants' claims presently on file. Therefore, applicants respectfully assert that all of applicants' claims are allowable. Such allowance at an early date is respectfully requested. The Examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

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